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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 10/823,605 | 04/14/2004 | Atsumasa Mizuno | 1086.1199 | 5079 |

21171 7590 08/19/2010

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| EXAMINER | |
|---|---|
| SENSENIG, SHAUN D | |
| ART UNIT | PAPER NUMBER |
| 3629 | |

| MAIL DATE | DELIVERY MODE |
|---|---|
| 08/19/2010 | PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/823,605 | MIZUNO, ATSUMASA | |
| | Examiner | Art Unit | |
| | Shaun Sensenig | 3629 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *5/28/2010*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1,16,17 and 19* is/are pending in the application.

4a) Of the above claim(s) *none* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,16,17 and 19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

This action is in response to papers filed on May 28, 2010.

Claims 1, 16, and 17 have been amended.

Claims 2-15 and 18 have been cancelled.

Claim 19 has been added.

Claims 1, 16, 17, and 19 are pending.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. **Claims 1, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chau et al. (Pub. No. US 2007/0260540 A1) (hereafter referred to as Chau) in view of Official Notice.**

4. In regards to **Claims 1, 17, and 19**, Chau discloses:

A support method for transition of contents service providers according to transition of portable telephone companies providing communication services the method performed by a computer processor of a support server, the method comprising:

receiving, by the computer processor, a request for transition from a first portable telephone company to a second portable telephone company from a customer terminal; (**120; [0035], lines 7-8; [0022], *shows customers entering information for comparison to other services using a customer terminal*; [0018], lines 6-13; [0047], lines 2-4, *shows plan comparisons between a customers current provider and a new provider*; and [0048], lines 1-2, *shows a customer being prompted to request a plan/transition***)

detecting, by the computer processor, a second content of a content group same as a first content to be available in the second portable telephone company, (**[0018], lines 6-10; [0047], lines 2-4, *shows plan comparisons between a customers current provider and a new provider being listed by closest match*; and [0039], *shows comparisons of competitive information being performed by a computer***) wherein

the customer file stores information of the first content; (**[0039], lines 12-14 and [0048], lines 4-6, *shows the saving of customer information and***

providing, by the computer processor, information about a new contract with a service provider of the second content to the customer terminal, when the service provider of the detected second content is different from the service provider of the first

content (**[0018], lines 6-13; [0047], lines 2-4; [0048], lines 1-2, *shows plan comparisons between a customers current provider and a new provider being listed by closest match***)

Chau discloses wherein the customer is not required to select a new service ([0048], lines 3-4, *"Whether or not the customer chooses to accept one of the offers"*), but Chau does not explicitly disclose providing the customer with information regarding the continuation of a current contract when the customer does not find a service that is preferable.

However, **allowing customers to continue contracts for current services** is old and well known to those of ordinary skill in the art, and official notice to that effect is hereby taken. For example, many times, when the contracted term is up, customers are given the opportunity to renew the contract at the same terms or continue with the same terms on a month-to-month basis.

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Chau so as to have included providing the customer with information regarding the continuation of a current contract when the customer does not find a service that is preferable, since each element performs the same function in the combination as it does alone, and doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results. (See KSR [127 S Ct. at 1739] "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.")

Chau discloses wherein data related to information regarding the comparison of multiple providers is saved as shown in the above rejection(s), but Chau does not explicitly disclose saving this information in a “service map file”.

However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have included the use of “service map files” as a design choice (See KSR [127 S Ct. at 1739] "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results."), since it would simply be *a different format of representing the same data that is saved in the database* and doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results

**Claim 19** recites substantially similar limitations to Claims 1 and 17. Although it uses different language the material and concepts are the same and therefore rejected using the same art and rational set forth above

5. **Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chau in view of Official Notice in further view of Namiki et al. (Patent No. JP 2002175431 A) (hereafter referred to as Namiki).**

6. In regards to **Claim 16**, Chau discloses all of the above limitations. Chau does not explicitly disclose determining and notifying whether a customer qualifies for contents service transition based on predetermined criteria, however, Namiki teaches determining and notifying whether a customer qualifies for contents service transition

based on predetermined criteria ([0061], *lines 1-4, shows the use of customer information (track record) to determine qualifications for transition eligibility*).

It would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Chau so as to have included determining and notifying whether a customer qualifies for contents service transition based on predetermined criteria as taught by Gans since the claimed invention is merely a combination of old elements that would perform the same functions as they would perform separately (See KSR [127 S Ct. at 1739] "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results."), since doing so could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

While Chau discloses retrieving customer information using an identification code (“opportunity code”), Chau does not disclose that the identification code is a telephone number.

However, the Examiner asserts that the data identifying telephone numbers is simply a label for identification code and adds little, if anything, to the claimed acts or steps and thus does not serve to distinguish over the prior art. Any differences related merely to the meaning and information conveyed through labels (i.e., customer information) which does not explicitly alter or impact the steps of the method does not patentably distinguish the claimed invention from the prior art in terms of patentability.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to used a telephone number as an identification code because code itself does not functionally alter or relate to the steps of the method and merely labeling the information differently from that in the prior art does not patentably distinguish the claimed invention.

### *Response to Arguments*

1. Applicant's arguments filed May 28, 2010 have been fully considered but they are not persuasive.

2. I. Rejection of Claims under 35 U.S.C. §103

Applicant's arguments in regards to the 35 U.S.C. §103 rejections are moot in view of the new prior art rejections. Additionally, Applicant's remarks contain merely assertions and do not contain any arguments or evidence.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shaun Sensenig whose telephone number is (571) 270-5393. The examiner can normally be reached on Monday to Thursday 7:30 to 5:00 ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571)272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. S./
Examiner, Art Unit 3629
August 11, 2010

/Jamisue A. Plucinski/
Supervisory Patent Examiner, Art Unit 3629